

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 5-11, 14-17, and 20-24 are currently pending. Claims 1, 8, and 16 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1, 2, 5, 6, 8, 9, 11, 14-17, 20, 21, 23, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,330,070 to Toyoda et al. (hereinafter “the ‘070 patent”) in view of U.S. Patent No. 5,917,615 to Reifman et al. (hereinafter “the ‘615 patent”); and Claims 7, 10, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘070 and ‘615 patents, further in view of U.S. Patent No. 6,512,593 to Yashiki (hereinafter “the ‘593 patent”).

Amended Claim 1 is directed to a method for transmitting a facsimile, comprising: (1) creating an image; (2) inputting parameters of a fax machine to a graphical user interface of a general purpose computer, the parameters including a password of the fax machine; (3) forming an electronic mail address that includes an Internet electronic mail address of the fax machine, the input password of the fax machine, and a fax number of a second fax machine; (4) generating a fax request as an electronic mail message, the electronic mail message including electronic mail address and the image; and (5) transmitting the electronic mail message to the fax machine. Claim 1 has been amended to clarify that the fax machine has only one password and the password of the fax machine is always included in the electronic mail address even if the image is not to be sent to the second fax machine. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.¹

¹ See, e.g., Figs. 6 and 7 and the disclosure on pages 8 and 9 of the specification.

Applicants respectfully submit that the rejection of Claim 1 (and dependent Claims 2, 5, and 6) is rendered moot by the present amendment to Claim 1.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '070 patent discloses everything in Claim 1 with the exception of inputting the parameters of a fax machine to a graphical user interface of a general purpose computer, and relies on the '615 patent to remedy that deficiency.

The '070 patent is directed to a method for receiving and relaying an e-mail message based on whether a public mail address or a non-public mail address is used. In particular, as shown in Figs. 4 and 5, the '070 patent discloses a method in which, if a first password name is used, the message is printed at the relay fax machine, whereas if a second password name is used along with a destination telephone number, the message is sent to the fax machine at the destination telephone number. However, Applicants respectfully submit that the '070 patent fails to disclose that the fax machine has only one password and the password of the fax machine is always included in the electronic mail address, even if the image is not to be sent to the second fax machine, as recited in amended Claim 1. Rather, the '070 patent discloses the use of two different password names in the electronic mail address, one for relay and one for public use.

The '615 patent is directed to a system and method for a facsimile load balancing. However, Applicants respectfully submit that the '615 patent fails to disclose that a fax machine has only one password and the password of the fax machine is always included in an electronic mail address, even if the image is not to be sent to the second fax machine, as recited in amended Claim 1.

Thus, no matter how the teachings of the '070 and '615 patents are combined, the combination does not teach or suggest that the fax machine has only one password and the password of the fax machine is always included in an electronic mail address, even if the

image is not to be sent to the second fax machine, as recited in amended Claim 1.

Accordingly, Applicants respectfully submit that amended Claim 1 (and dependent Claims 2, 5, and 6) patentably define over any proper combination of the '070 and '615 patents.

Independent Claims 8 and 16 recite limitations analogous to the limitations recited in Claim 1. Moreover, Claims 8 and 16 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 8 and 16 (and all similarly rejected dependent claims) are rendered moot by the present amendment to Claims 8 and 16.

Regarding the rejection of Claims 7, 10, and 22 under 35 U.S.C. § 103, Applicants respectfully submit that the '593 patent fails to remedy the deficiencies of the '070 and '615 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejections of Claims 7, 10, and 22 are rendered moot by the present amendment to the independent claims.

Claim 23 recites a graphical user interface, comprising: (1) a control window configured to input fax parameters of a fax machine; (2) a settings window configured to input setup parameters of the fax machine and mail parameters in order to send an electronic mail message, the setup parameters including a password of the fax machine; and (3) a print window configured to select a print driver to convert a computer document to a fax format.

Regarding the rejection of Claim 23 under 35 U.S.C. § 103, the Office Action refers to the rejection of Claim 11 and Figs. 24, 25, 80-83, and 94 of the '615 patent. However, Applicants respectfully submit that the '615 patent fails to disclose a print window configured to select a print driver to convert a computer document to a fax format. The figures cited by the Office Action fail to disclose the selection of a print driver. Further, Applicants respectfully submit that the '070 patent fails to remedy the deficiencies of the

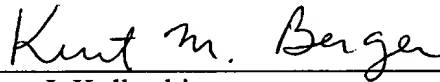
'615 patent. Accordingly, Applicants respectfully submit that no matter how the teachings of the '070 and '615 patents are combined, the combination does not teach or suggest the print window recited in Claim 23. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection of Claims 23 and 24 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 8, 16, and 23 (and all associated dependent claims) patentably define over any proper combination of the '070, '615, and '593 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648
Kurt M. Berger, Ph.D.
Registration No. 51,461

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

JJK/KMB/law

I:\ATTY\KMB\196'S\196033US\196033US-AFTER FINAL AM.DOC